

REMARKS

Claims 1-3, 5-7, 9-11, 13, and 15-19 are pending in the present application. With entry of this Amendment, Applicants amend claims 1, 5, 9, 13, 18, and 19. Applicants further add new claims 20-23. No new matter has been added. Reexamination and reconsideration are respectfully requested.

Applicants wish to thank the Examiner for the telephonic interview on Tuesday, April 6, 2010. During this interview, claims 1 and 5 were discussed. The Examiner agreed with Applicants that Wiser did not anticipate or render claim 5 obvious. More particularly, the Examiner agreed that neither Wiser nor Kenner discloses or teaches "reproduction limiting information." The Examiner also suggested an amendment to claim 5 for clarity only: replacing the term "receiving" with the term "downloading." Claim 5 has been accordingly amended. Independent claims 1, 9, 13, and 19 have been similarly amended. Support for this amendment can be found throughout the specification, including paragraph 0048 of the published application.

In the Office Action dated January 22, 2010, the Examiner rejected the pending claims under 35 U.S.C. § 103(a) as being unpatentable over Wiser et al. (U.S. Patent No. 6,385,596) in view of Kenner et al. (U.S. Patent No. 5,956,716).

A. Neither Wiser nor Kenner Discloses or Suggests *Reproduction Limiting Information*

A user can conventionally obtain a preview version of a song, such as from the Internet. If he likes it, he can order a purchase version. One drawback to this approach is that two versions of the song – the preview version and the purchase version – are sent to the user with these two separate transactions.

The present invention overcomes this drawback by storing performance data at the user terminal *only once*. The performance data is associated with the content of a music performance, such as a song. With either a preview or a purchase, a server transmits both performance data and order information. The performance data includes "reproduction limiting information."

Reproduction limiting information limits the reproduction state of the content of the music performance. The reproduction limiting information, however, is read *only when the order is for a preview*. If the order is for a purchase, the reproduction limiting information is not read and performance data is reproduced without limitation.

When a preview is stored initially, order information and performance data are both stored in storage. If a purchase of the same performance data is requested, the client downloads both the performance data and the order information. This may be stored, for example, in a temporary cache. The present invention determines whether the song data, including both the performance data and order information, has already been stored in storage. Because this example has already downloaded the performance data, the order information, *but not the performance data*, is rewritten to the storage. This new order information for a purchase does not restrict the performance data as did the order information from the preview, and the performance data can be reproduced in its entirety. In this way, *a single version of the performance data can be stored and then reproduced differently based on the order information*.

That is, once the performance data is stored by the user, it is *never rewritten*. Rather, the *order information is changed* to have the performance data read in full.

1. Claim 5

Amended claim 5 recites, in part:

[D]ownloading song data from the server in response to the order, the song data being composed of performance data and order information corresponding to the performance data, the performance data representing the content of the music performance and containing *reproduction limiting information* for limiting a reproduction state of the content of the music performance. (Emphasis added.)

a. *Wiser Teaches Away from Reproduction Limiting Information*

Applicants respectfully submit that a difference between Wiser and the present invention is Wiser's lack of reproduction limiting information. Wiser discloses creating two versions or audio images of a song – a full-length purchase version and a shortened clip or preview version – and stores them separately in a media data file. (See, e.g., col. 3, lines 51-63 and col. 7, lines 4-16.) A voucher ID 302 is used as a flag to indicate either a preview or purchase transaction. (See col. 8, lines 31-32.) More simply put, the voucher ID 302 specifies which file, the preview media file or the purchase media file, should be sent to the client system. Wiser thus not only fails to teach reproduction limiting information, but also clearly *teaches away* from the element of reproduction limiting information, given that two separate versions of a song are stored on a client if a user first previews and then purchases the same song. Indeed, the Examiner stated in his Office Action dated April 29, 2009 that he found Applicants' request for the removal of finality of the rejection based on Wiser persuasive. He then provided Kenner as the sole reference for rejection in the same Action.

b. *Kenner Does Not Make Up for the Deficiencies of Wiser*

Kenner does not make up for the deficiencies of Wiser. Kenner discloses a "premium subscription service." (col. 21, lines 35-45.) In this service, the user requests a video clip, but the system only provides the video clip when a subscription condition is met. (See, e.g., col. 24, lines 47-67.) Kenner teaches a video may be broken into segments. (See, e.g., col. 31, line 65 – col. 32, line 8.) However, there is no discussion in Kenner of the system providing a video for purchase, where reproduction limiting information is received as part of the information included in the video. Kenner merely provides videos for purchase. It does not disclose downloading song data from the server in response to the order, the song data being composed of performance data and order information corresponding to the performance data, the performance data representing the content of the music performance and containing reproduction limiting information for limiting a reproduction state of the content of the music performance, the order information indicating at least either a purchase or a preview associated with a usage right of the content of the music performance. Furthermore, the Examiner removed his rejection based on Kenner in the Office

Action dated January 22, 2010. He then combined Kenner with Wiser in the same Action. Given that Wiser teaches *away* from the present invention and Kenner does not disclose the present invention, the combination of Kenner and Wiser cannot disclose claim 5.

Applicants respectfully submit that each of the above reasons are sufficient for rendering amended claim 5 patentable over Wiser in view of Kenner. Accordingly, Applicants respectfully request that the Examiner reconsider his rejection of claim 5 based on Wiser in view of Kenner.

2. Claims 1-3, 6-7, 9-11, 13, and 15-23

Amended claims 1, 9, 13, and 19 similarly recite “reproduction limiting information” and are patentable over Wiser in view of Kenner for at least the reasons set forth above. Claims dependent on claims 1, 5, 9, 13, and 19 are likewise patentable over Wiser in view of Kenner for at least the reasons set forth above for the independent claims.

B. The Apparatus Claims of the Present Invention Recite Patentable Subject Matter

During the telephonic interview on April 6, 2010, the Examiner also raised some issues regarding claim 1. Applicants respectfully request that the Examiner reconsider his concerns in light of the amendments and arguments below. The Examiner’s first concern was whether claim 1 recited patentable subject matter under 35 U.S.C. § 101. This is clearly the case as discussed below as it is directed to a machine and achieves a transformation, i.e. performance data (e.g. a song) is reproduced.

1. Determining Whether an Algorithm is Applied in Any Manner to Physical Elements or Process Steps is *Not* a Valid Test

The Federal Circuit has provided the current test in determining whether claimed subject matter is patentable under U.S.C. 35 § 101. *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). The court found that the U.S. Supreme Court has already rejected “dissecting a claim and evaluating patent-eligibility on the basis of individual limitations.” *Id.* at 959 (citing *Parker v. Flook*, 437 U.S. 584, 594 (1978)) (requiring analysis of a claim as a whole regarding § 101 analysis). Therefore,

rejecting claim 1 as failing to meet the standards of § 101 because of particular points in the claim does not meet the standard set by the Supreme Court.

2. The Appropriate Test is the Machine-or-Transformation Test That Considers the Claim as a Whole

The *Bilski* court held that a claim involving an algorithm transforming an article “to a different state or thing” provides for patentable subject matter. *Id.* at 954. The court came to this determination in part because of the Supreme Court’s *Diamond v. Diehr* decision, which held that Diehr’s claims were patentable under § 101. *Id.* Diehr claimed a computer-implemented method that involved the transformation of raw rubber into cured rubber products. *Diehr*, 450 U.S. 175, 187 (1981). *Bilski*, however, claimed a “method for managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price.” *Id.* at 949. The Federal Circuit differentiated between Diehr’s claims and *Bilski*’s claims, saying that *Bilski*’s “claimed process here as a whole is directed to the mental and mathematical process of identifying transactions that would hedge risk... the claims [do not] require the use of any particular machine or achieve any eligible transformation.” *Id.* at 965. Therefore, the test for a claim under § 101 is to ensure that a machine is used or that a transformation is achieved.

3. Claim 1 Is Patentable Using the Machine-or-Transformation Test

First, the present invention’s claim 1 recites an apparatus with specific sections, which falls under § 101 for a “machine” rather than a method performed by an apparatus. However, a discussion of the transformation of the end product is provided below.

Claim 1 provides for a reproduction control section that reproduces performance data. As shown in Fig. 1, the sound system 11 may reproduce the performance data for the user, either as a preview or purchase. If the identified usage right indicates a preview, the reproduction control section *reproduces* only the specified portion of the performance data, and *does not reproduce other portions of the content of the performance data* than the specified portion. If the identified usage right indicates a purchase, the reproduction control section *reproduces all of the performance data*. Amended claim 1 recites patentable subject matter in that it recites reproduction of a specified

portion or all the performance data reproduction of a specified portion or all the performance data. Such a reproduction of performance data from a binary form to e.g., audio signals provides the necessary *transformation* required.

C. The Specification Provides Support for the Recited Claim Elements of Claim 1

The Examiner further expressed his concern that claim 1 may not have support from the specification in the telephone interview. Claim 1 meets the requirements as set forth by 35 U.S.C. § 112, first paragraph:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 1 Recites Patentable Material and Is Supported by the Specification

Applicants have also provided below a mapping of the elements of claim 1 to exemplary portions of the specification for the Examiner to consider:

Claim 1 Elements	Exemplary Portions of Specification U.S. Patent Publication 2004/0154459
Song data reproduction apparatus	Paragraph 0061; Fig. 1, UT
Transmitting section	Paragraph 0052; Fig. 1, (8); Fig. 3(2), (U1)
Receiving section	Paragraph 0056; Fig. 1, (8); Fig. 3(2), (U2)
Storage section	Paragraph 0021; Fig. 1, (4)
Determining section	Paragraph 0056; Fig. 1, (1) (2); Fig. 3(2), (U3)
Writing section	Paragraphs 0057-0058; Fig. 1, (1) (2); Fig. 3(2), (U4 and U5)
Usage right identification section	Paragraph 0020; Fig. 1, (1) (2); Fig. 4, (U13 and U14)
Limiting information read section	Paragraph 0020; Fig. 1, (1) (2); Fig. 4, (U15)
Reproduction control section	Paragraph 0020; Fig. 1, (1) (2); Figs. 4 & 5, (U16-U18), (U22-U28)

As described above, elements of claim 1 are supported in full by the specification and meet the requirements of § 112.

2. Claims 2-3, 13, 15, 16, 19, 20 and 23 Recite Patentable Material and Are Similarly Supported by the Specification

Claims 13 and 19 similarly recite patentable subject matter and are supported throughout the specification. Claims dependent on claims 1, 13, and 19 likewise recite patentable subject matter and are supported throughout the specification.

D. The Specification Provides Support for the Recited Claim Elements of Claim 1

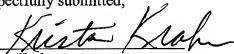
Included in the Information Disclosure Statement provided along with this response is an Office Action from the European Patent Office dated December 2, 2009 which references Matsumoto et al. (U.S. Patent Publication No. 2002/0103759), submitted in the Information Disclosure Statement on June 26, 2009. Although provided for completeness under 37 C.F.R. 1.56 (1), Applicants submit that the references provided do not disclose or teach at least order information indicating either of a purchase or a preview.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Docket No. 393032043200. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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